

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed June 7, 2007. At the time of the Final Office Action, Claims 1-18 were pending in this Application. Claims 1-18 were rejected. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-7, 9-16 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 4,296,887 issued to Karl Hoffmann ("Hoffmann") in view of U.S. Patent 4,566,316 issued to Kiyoshi Takeuchi ("Takeuchi"). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claims 8 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hoffman and Takeuchi as applied to Claims 1 and 10 above, and further in view of U.S. Patent 5,226,397 issued to Sebastian Zabeck et al. ("Zabeck"). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 13 recites "a bearing surface of the injection valve being pretensioned against a bearing surface of the cylinder head in such a way that the hole is sealed, wherein the nozzle body is disposed between the sealed bearing surfaces and the combustion chamber . . . , wherein the pressure sensor is surrounded by a sealing ring, and the sealing ring is tensioned between the injection valve and the cylinder head and seals the hole." According to the specification,

A sealing ring 18, which is clamped between the annular surface 5 of the cylinder head 1 and the injection valve 7 is provided for sealing of the hole 2 upwards. The sealing ring 18 surrounds the pressure sensor 16. The injection valve 1 is pretensioned via tensioning means not shown in the diagram against the sealing ring 18. The combustion chamber 21 is sealed by the sealing ring 18.

(Specification at [0019]). A premise of the rejection is that Hofmann teaches "a sealing ring (feature 23; claim 3)." (Final OA at 2). However, Hofmann merely teaches that "[a] shoulder 31 of the unitary bushing 30 fits against a copper sealing ring 35 which, in turn, is seated on a shoulder of the cylinder head." (Hofmann, 2:62-65). Hofmann does not teach a pressure sensor, much less, a pressure sensor surrounded by a sealing ring. Further, Takeuchi also does not teach a pressure sensor surrounded by a sealing ring. Rather, Takeuchi teaches "[t]he sensor 1 is held between a projection 23c of the plug 23 and the cylinder head 21." (Takeuchi at 1:35-37). Takeuchi actually teaches away from the invention by teaching that all of the "force for fastening" is subjected to the sensor 1. (Takeuchi at 1:38-39). Thus, the cited prior art fails to teach or suggest the combination of a pressure sensor and a pretensioned seal, so that the invention as claimed in claim 13 is patentable. The invention as claimed in claims 11-12 and 14-18 is patentable for similar reasons.

Claim 3 recites that the "sleeve is covered at least partly on its outer and/or inner surface by a coating which reduces friction." According to the specification,

Preferably the sleeve 13 has a coating 19 on its outer side or its inner side. The coating 19 is preferably embodied as a PFTE layer. The coating 19 is used to avoid contamination reaching the surface of the sleeve and/or to reduce friction

between sleeve and the nozzle body or between the sleeve and the cylinder head.
Other suitable coatings can also be used instead of the PFTE coating.

(Specification at [0020]). A premise of the rejection is that the Hofmann device is “constructed for heat protection or ‘making contamination more difficult’ (column 1, line 5-10; claim 1).” However, Hofmann does not disclose a coating or that the sleeve should reduce friction. Takeuchi fails to teach a sleeve. Therefore the invention as claimed in claim 3 is patentable in view of the prior art cited. The invention as claimed in claims 2 and 4-9 is patentable for similar reasons.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2690.

Respectfully submitted,
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